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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,856	03/30/2001	David W. Cannell	05725.0877-00	7050

22852 7590 07/29/2003

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 07/29/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary <i>File copy</i>	Application No.	Applicant(s)	
	09/820,856	CANNELL ET AL.	
	Examiner	Art Unit	
	JYOTHSNA A VENKAT	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-216 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) See Continuation Sheet is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11</u> . | 6) <input type="checkbox"/> Other: |

Continuation of Disposition of Claims: Claims rejected are 1-15,30,38-40,53-74,89,97-100,110-124,139,147-150,160-171,186,194-197 and 207-216.

Continuation of Disposition of Claims: Claims objected to are 16-29,31-37,41-52,75-88,90-96,101-109,125-138,140-146,151-159,172-185,187-193 and 198-206.

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DETAILED ACTION

1. Receipt is acknowledged of amendment A, declaration n, IDS and terminal disclaimer all filed on 5/7/03. Claims 1-216 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-15, 30, 38-40, 53-74, 89, 97-100, 110-124, 139, 147-150, 160-171, 186, 194-197 and 207-216 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Harry's Cosmetology by Ralph Harry pp 470-483 (1982), U. S Patent 6,235,298 ('298) and U. S. Patent 5,688, 930 ('930).

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The instant application is claiming composition and method for durable non-permanent shaping of at least one keratinous fiber or durable retention of non-permanent shape of at least one keratinous fiber comprising:

- 1. At least one film-forming agent*
- 2. At least one compound chosen from C_3 - C_5 monosaccharides substituted with at least one C_1 - C_{22} carbon chain where in the monosaccharides is pentoses*
- 3. Additional saccharide, which is polysaccharide*
- 4. Additives*

Harry's cosmetology teaches component 1 and component 4. See pages 475-478 for the various resins which is also claimed by applicants as the film-forming agent. See also the examples in the cited pages for the various additives. The Cosmetology does not teach the specific Polyquaternium claimed in the instant application. Patent '298 teaches polyquaternium claimed in the instant application as the film-forming agent along with components 3-4. See col.7, line 35 for the hair fixative former or film former along with various film formers claimed in the instant application. The patent also teaches polysaccharides as the amphoteric surfactant. See col.18, lines 45 et seq. See also the examples. The only difference between these two documents is both the documents do not disclose ingredient 2. However the patent '930 teaches ingredient 2 as the surfactant. See the abstract, See col.3, lines 33 et seq where the compounds taught are the pentoses substituted with alkyl chains. See also col.4, col.6, lines 10 et seq and see the examples and see specially examples 33-36.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of 'Harry's Cosmetology and Patent '298 and

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combine it with the *substituted* saccharides of '930, expecting beneficial effect to the hair. The motivation to use the *substituted* saccharides stems from the teachings of '930 that the compositions provide emulsifying, foaming and wetting and dispersant properties. This is a *prima facie* case of obviousness.

The test results in the specification are not commensurate with the scope of the claims.

Response to Arguments

5. Applicant's arguments filed 5/7/03 have been fully considered but they are not persuasive.

Applicants argue that the combination of references is improper as one would have to selectively pick and choose among isolated passages of Harry's Cosmetology, Naser and Bertho to arrive at the claimed invention and the Cosmetology is directed to hair sprays.

In response to the above argument, it is the examiners position that the Cosmetology teaches film formers and additives claimed in the instant application. The cosmetology teaches the polymers used in the hair setting lotions, sprays and dressings. The cosmetology under this chapter clearly teaches the film formers that are used. The pages are provided to applicants to show that these polymers are used in the art for shaping the hair.

Applicant's argue that Naser teaches a long list of exemplary hair fixatives and one of ordinary skill in the art would have to first select a hair fixative from the long list of topically active compounds and then choose the polyquaternium among the numerous exemplary film formers.

In response to the above argument, it is the position of the examiner that Naser exemplifies film formers. The patent names the polyquaternium claimed in the instant

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application as hair fixative polymer. One of ordinary skill in the art would be motivated to use the hair fixative of '298 as all the references are in the same field of endeavor.

6. **In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).**

7. It is the examiners position that one of ordinary skill in the art would be motivated to prepare compositions of 'Harry's Cosmeticology and Patent '298 and combine it with the *substituted* saccharides of '930, expecting that the compositions provide emulsifying, foaming and wetting and dispersant properties.

Allowable Subject Matter

8. Claims 16-29, 31-37, 41-52, 75-88, 90-96, 101-109, 125-138, 140-146, 151-159, 172-185, 187-193, 198-206 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

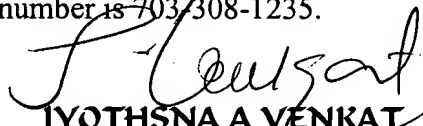
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


JYOTHSNA A VENKAT
Primary Examiner
Art Unit 1615

July 24, 2003